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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,037	11/06/2003	Werner Bloch	16202.960	7406
7590 Joseph W. Berenato, III Liniak, Berenato & White, LLC Suite 240 6550 Rock Spring Drive Bethesda, MD 20817			EXAMINER BLOUNT, ERIC	
			ART UNIT 2612	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/06/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/702,037	BLOCH, WERNER	
	Examiner	Art Unit	
	Eric M. Blount	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 November 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04142004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 2 and 3 are objected to because of the following informalities: Claims 2 and 3 appear to overlap in the presented claims. Each claim should be 1 sentence form and start on a separate line of the page. Appropriate correction is required.

2. Claims 5, 7, 9, 11, 14-16, and 19 are objected to because of the following informalities: It appears applicant has made an attempt to amend the dependency of the claims. Applicant is advised to strikethrough the text that should be deleted. Examiner has considered the claims using the dependency, which is either underlined, or not in brackets. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 8, 9, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding the claims, the phrase "in particular" renders the claim indefinite because it is unclear what limitations are set forth by the claims. To be more specific, it is unclear if the limitations following the phrase are the only limitations to be considered or if those limitations are exemplary.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Senba et al [US 7,088,249 B2].

As for **claim 1**, Senba discloses a method for fitting a transponder with a chip and a coil to a metal body, characterized in that:

- a. the coil is wound in the form of a bar and is electrically connected at its ends to the electrical connections of the chip, forming a transponder (Figure 4, column 9 lines 12-29); and
- b. the transponder formed in this way is introduced in its entirety into a cavity in the metal body in such a manner that the coil axis lies parallel to the metal surface, and at least part of the coil is positioned in the region of a window in the metal body (Figures 8 & 9, Figure 9, shows a slit (11e) that is interpreted as a window. Flux leakage path (12) is also interpreted as a window).

As for **claim 2**, Senba discloses that the cavity is a groove in the surface of the metal body ((42) column 18, lines 10-26);

As for **claim 3**, Senba discloses that the transponder is introduced into the cavity in a manner that is essentially completely surrounded by metal except for the region of the window (See the figures);

Regarding **claim 4**, Senba discloses that the transponder is introduced into a hole, which runs parallel to the surface of the metal body, as a cavity (See figures 8 & 9).

As for **claim 5**, the window in whose region the coil is positioned is smaller than the transponder (See figure 9 (11e)).

As for **claim 6**, the window has a shorter length and/or a narrower width than the coil of the transponder (Senba discloses a slit (11e) with a narrower width than the coil (column 14, lines 48-53)).

As for **Claim 7**, Senba discloses that the transponder is embedded in glass or a flexible resin forming a transponder (column 17, lines 6-10 (Flexible resin is viewed as an elastic material)).

As for **claim 15**, depending on any of the preceding claims, the coil is wound on a ferrite core (column 9, lines 23-29).

7. Claims 16-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hadden et al [US 5,223,851].

As for **claim 16**, as best understood, Hadden discloses a transponder module having a transponder which has a chip and a coil, which is electrically connected to it, and is embedded in an elastic material, characterized in that the coil is wound in the form of a bar, the transponder is

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introduced into a sleeve which is tubular, and the sleeve is filled with the elastic material (Figures 1, 4, and 5; column 3, lines 20-25; column 4, lines 45-60; and column 5, lines 14-35).

As for **claims 17 and 18**, as best understood, the tubular sleeve is open at one end and closed at the other (column 4, lines 45-53).

As for **claim 20**, the coil, which is in the form of a rod, is aligned parallel to the longitudinal axis of the sleeve (See figures 4 and 5).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-16, 18, 19, and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Senba

As for **claim 8**, as best understood, Senba does not disclose that a soft plastic material is used as the elastic material. As stated above in discussion of claim 7, Senba discloses the use of a flexible resin. However, using general knowledge, it would have been obvious to the skilled artisan at the time of the invention by the applicant to encapsulate the transponder in any well-known elastic material, including silicone or polyurethane. Applicant has not shown why the choice of these two materials would be advantageous over all other elastic materials.

As for **claims 9 and 10**, as best understood, the transponder module is introduced into a sleeve composed of a non-metallic material (Senba column 17, lines 6-10). The glass or plastic

container taught by Senba is interpreted as a sleeve. It would have been obvious to one of ordinary skill in the art to provide additional layers of non-metallic material if the environment for mounting the transponder required a higher degree of transponder safety.

As for **claim 11**, as best understood, the sleeve (container) is tubular and the transponder is introduced into the sleeve such that the coil axis runs parallel to the tube axis (See figures).

As for **claim 12**, Senba discloses that the cavity in the metal body is encapsulated with a non-metallic elastic material once the transponder has been introduced (column 18, lines 20-26).

As for **claim 13**, Senba discloses that resin is used as the encapsulation material (column 18, lines 20-26).

As for **claim 14**, Senba does not specifically disclose that the encapsulation material is harder than the elastic material in which the transponder is embedded. However, it would have been obvious to one of ordinary skill in the art that the elastic material for encapsulating the transponder would have been a softer material, so as to allow for flexibility.

As for **claim 15**, depending on any of the preceding claims, the coil is wound on a ferrite core (column 9, lines 23-29).

As for **claim 16**, the claim is interpreted and rejected using the same reasoning as claims 1 and 7-10 above.

As for **claim 19**, the coil is wound on a ferrite core (Senba, column 9, lines 23-29).

Regarding **claim 20**, the coil is aligned parallel to the longitudinal axis of the sleeve (see Figures).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Blount whose telephone number is (571) 272-2973. The examiner can normally be reached on Monday-Thursday 8:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric M. Blount
Examiner
Art Unit 2612



BENJAMIN C. LEE
PRIMARY EXAMINER